

**Remarks**

Applicants thank the Examiner for his careful consideration of the application.

Claims 1 – 22 are pending in the application.

**Claim Rejections – 35 USC § 112**

The Examiner rejected claims 6, 7, 13, 14, 16, 17, 21, and 22 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse these rejections.

The Examiner rejected claims 6 and 7 as lacking support in the written description for use of a tag in a cell phone or PDA. Applicants believe adding a tag such as, for example, an RF tag, to a cell phone or PDA would be fairly straightforward and not require significant experimentation. Applicants do not know whether it is well-known in the art, but would be surprised if it took much effort to accomplish.

The Examiner rejected claims 13 and 14 as not being novel enough. Applicants are confused by the Examiner's rejection. The Examiner appears to be making a novelty rejection. In which case, the Examiner should have made such rejection under the section containing the other 35 USC § 102 rejections. Bar codes, both one and two-dimensional, are well-known in the art. However, the Examiner has not articulated how that could possibly be the basis for a valid 35 USC § 112 rejection.

The Examiner rejected claims 16 and 17 as lacking enabling support in the written description for how to use fax numbers and e-mail addresses to send print jobs. Many printing devices today can be used to scan and e-mail or fax documents. These devices have existed for years. Applicants envisioned storing one or more fax numbers and/or e-mail addresses on a tag that would be scanned by a device and used to complete the transmission of a document.

The Examiner rejected claim 21 as lacking sufficient support in the written description for connecting an output device to the internet. The Examiner appears to be concerned about transmitting raw tag information over the internet, which Applicants do not claim. Many output devices, such as multi-function devices, are connected to

the internet. Applicants are not claiming sending raw tag information over the internet other than as part of a print job. However, the tag information may be communicated over the internet if embodied in the generated advertisement.

The Examiner rejected claim 22 as lacking sufficient support in the written description for associating a tag with a broach, tie clip, or pen. Incorporating tags that use 1-d and 2-d bar codes or RF tags should be easy enough. It does not matter whether the information is inconspicuous or externally visible.

#### **Claim Rejections - 35 USC § 102**

The Examiner rejected claims 1 – 8, 11, 12, 15, 16, and 18 – 22 under 35 USC § 102(e) as being anticipated by Shahindoust (US Pub. No. 2004/0190038) "Shahindoust". Applicants respectfully traverse these rejections.

In claim 1, Applicants recite a method for completing a print job. The method includes delivering at least one print job to a printing device, bringing a tag containing information to be incorporated into the print job into close proximity to the printing device so that the device receives the information from the tag, and incorporating the information received from the tag into the print job.

The Examiner should withdraw the rejection to claim 1 over Shahindoust as the Examiner has not shown that Shahindoust discloses, for example, incorporating information received from a tag into a print job. Shahindoust appears to disclose a tag containing either user information or billing information. The Examiner has not shown that information such as, for example, e-mail addresses (including a billing e-mail address), fax numbers, personal printing preferences, or related print jobs are used to complete a print job. Applicants describe that all of the preceding may be incorporated into a print job to complete the print job. For the foregoing reasons claim 1 should be allowed over Shahindoust.

The Examiner should allow claims 2 – 8, 11, and 12 if claim 1 is allowed as claims 2 – 8, 11, and 12 depend from claim 1.

In claim 15, Applicants recite a method for transferring documents from one location to another. The method includes sending at least one document to be transferred to the queue of a device having document transmission capabilities, bringing an electronic tag containing information in close proximity to a tag reader operably connected to the device having document transmission capabilities so that the tag may be read and information is received by the device. Finally, using the information received from the tag to transmit the document.

The Examiner should withdraw the rejection to claim 15 over Shahindoust as the Examiner has not shown that Shahindoust discloses, for example, using information received from a tag to transmit a document. The passages cited by the Examiner appear to disclose using a Bluetooth enabled smart card to authenticate a user, but the passage in question does not appear to disclose using information on the Bluetooth smart cards to transmit a document. For the foregoing reasons claim 15 should be allowed over Shahindoust.

The Examiner should allow claim 16 if claim 15 is allowed as claim 16 depends from claim 15.

In claim 18, Applicants recite a system for generating an advertisement. The system includes a tag encoded with advertising information, a tag reading device for reading the tag and receiving the advertising information therefrom, and an output device operably connected to the tag reading device, wherein the output device generates the advertisement.

The Examiner should withdraw the rejection to claim 18 over Shahindoust as the Examiner has not shown that Shahindoust discloses, for example, a tag encoded with advertising information or a tag reading device that receives the advertising information therefrom. As previously noted, the passages cited by the Examiner appear to merely disclose using a Bluetooth card for authentication purposes. The Examiner has not identified any portion of the application that appears to disclose using information stored on the Bluetooth card in a print job. Further, the Examiner has not pointed to

any passage in Shahindoust that discloses using advertising information from a tag to produce an advertisement.

The Examiner should allow claims 19 – 22 if claim 18 is allowed as claims 19 – 22 depend from claim 18.

### **Claim Rejections – 35 USC § 103**

The Examiner rejected claims 6, 7, 9, and 10, under 35 USC § 103(a) as being unpatentable over Shahindoust in view of Yajima et al. (US Pub. No. 2002/0016833) ("Yajima"). Applicants respectfully traverse these rejections.

Claims 6, 7, 9, and 10 depend from claim 1. As Applicants have previously argued, the Examiner has not established that Shahindoust discloses, for example, incorporating information received from a tag into a print job. The Examiner has not identified this limitation in Yajima either. Therefore, claims 6, 7, 9, and 10 should be allowed if claim 1 is allowed.

The Examiner rejected claims 13 and 14 under 35 USC § 103(a) as being unpatentable over Shahindoust in view of Harrison et al. (US Patent No. 6,249,226) ("Harrison"). Applicants respectfully traverse these rejections.

Claims 13 and 14 depend from claim 1. As Applicants have previously argued, the Examiner has not established that Shahindoust discloses, for example, incorporating information received from a tag into a print job. The Examiner has not identified this limitation in Harrison either. Therefore, claims 13 and 14 should be allowed if claim 1 is allowed.

The Examiner has rejected claim 17 as obvious over Shahindoust. Claim 17 depends from claim 15. As Applicants have previously argued, the Examiner has not established that Shahindoust discloses, for example, using information received from a tag to transmit a document. Therefore, claim 17 should be allowed if claim 15 is allowed as claim 17 depends from claim 15.

### Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,

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